

REMARKS

To date, the Examiner has not indicated that the subject matter of the information disclosure statement (IDS) filed 09/15/2005 has been properly considered. A copy of such IDS is submitted herewith. If the Examiner requires additional copies of any reference(s), applicant invites the Examiner to contact the undersigned. Documentation in the file wrapper of the instant application confirming the Examiner's consideration of the appropriate reference(s) is respectfully requested.

The Examiner has rejected Claims 1, 24, 28 and 36 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 7,263,561. Applicant respectfully asserts that such rejection has been overcome in view of the filing of the terminal disclaimer submitted herewith.

The Examiner has rejected Claims 1-6, 8-10, 12-15, 18-21, 23-30, 32, 34 and 41-44 under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (U.S. Patent No. 6,901,519) in view of Hargraves et al. (U.S. Provisional Application No. 60/289,814). In addition, the Examiner has rejected Claims 7 and 36-39 under 35 U.S.C. 103(a) as being unpatentable over Stewart, in view of Hargraves, and further in view of Schwabe et al. (U.S. Publication No. 2003/0028686). Applicant respectfully disagrees with such rejections.

With respect to the independent claims, the Examiner has failed to provide a specific prior art citation to address applicant's claimed technique "wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type... the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type" (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that none of the prior art reference excerpts relied on by the Examiner to meet the remaining limitations of applicant's independent claims even suggest "the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type," as claimed (emphasis added). Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Therefore, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to dependent Claim 7 et al., the Examiner has relied on Paragraph [0042] from the Schwabe reference to make a prior art showing of applicant's claimed "converting occurring at a desktop computer of the intended recipient."

Applicant respectfully asserts, that the excerpt from Schwabe relied on by the Examiner simply discloses that “[t]he conversion of a set of class files from, e.g., a Java application, to a CAP file 74 can generally occur on a desktop computer.” Clearly, only generally disclosing converting at a desktop does not specifically teach “converting occurring at a desktop computer of the intended recipient” (emphasis added), particularly where “a certain electronic file [is] intended for delivery from a sender to [the] intended recipient,” in the context claimed by applicant (see independent Claim 1 for context).

With respect to dependent Claims 23 and 41-44, the Examiner has failed to provide a specific prior art showing of the subject matter of such claims. Accordingly, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The

Commissioner is authorized to charge any additional fees or credit any overpayment to  
Deposit Account No. 50-1351 (Order No. NAI1P092).

Respectfully submitted,  
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